

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UWE KLINGLER,
THOMAS SCHIEB, DIETMAR WASTIAN,
GERHARD WIECHERS, and JURGEN ZIMMERMAN

Appeal No. 2000-0635
Application No. 08/511,028¹

ON BRIEF

Before McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and GARDNER-LANE, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

DECISION ON APPEAL

Applicants seek review under 35 U.S.C. § 134 of the
examiner's final rejection of claims 1-10. We AFFIRM.

BACKGROUND

The claims are directed to a process for the production
of a dinitrotoluene isomer mixture. According to applicants,
"[n]one of the claims will be argued separately" (Paper 11
(App. Br.) at 3). "Because the claims are not separately

¹ Application for patent filed 3 August 1995.

Appeal No: 2000-0635
Application No: 08/511,028

argued, they stand or fall together." In re Beattie, 974 F.2d
1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992).

Claim 1 is illustrative of the claimed invention and
reads as follows:

1. A continuous, single-stage process for
the production of a dinitrotoluene isomer mixture
comprising
A) reacting
1) toluene
with
2) a nitrating acid composed of
(a) from about 80 to about 100% by
weight of inorganic constituents
which include
(i) from about 60 to about 90%
weight of sulfuric acid,
(ii) from about 1 to about
weight of nitric acid,
and
(iii) at least 5% by weight of
water,
and
(b) from 0 to about 20% by weight of
organic constituents which
include
(i) at least 70% by weight
dinitrotoluene isomers and
(ii) from 0 to about 30% by
weight
by-products
under adiabatic conditions in amounts such
that the molar ratio of nitric acid to
toluene is at least 1.5:1 and such
that some mononitrotoluene will remain in
the reaction mixture,
B) removing at least 5% by weight of
water from the reaction mixture of A),
C) removing the reaction mixture of B) at
a temperature of at least 120E C,

Appeal No: 2000-0635
Application No: 08/511,028

- C) D) separating the reaction mixture from
 into an acid phase and an organic
 phase containing dinitrotoluene,
- and E) recovering the dinitrotoluene from the
 organic phase separated in D).

All the claims were finally rejected under the judicially created doctrine of obviousness-type double patenting in view of the claims of U.S. patent 5,345,012 to Schieb et al. (Schieb)² and under 35 USC § 103 in view of the disclosure of Schieb. The claims were also finally rejected under the judicially created doctrine of obviousness-type double patenting in view of the claims of copending application 08/510,992 ('992)³; however, the examiner withdrew the rejection based on the '992 claims in the examiner's answer (Paper 12 (Ex. Ans.) at 2-3).

In maintaining the rejection of claims 1-10 over Schieb, the examiner states (Paper 12 at 4):

Although the conflicting claims are not identical, they are not patentably distinct from each other because Schieb et al. teach (1) that the molar ratio of nitric acid to toluene is maintained at a level of at least 2:1, whereas the instant invention discloses of (sic) a molar ratio of at least 1.5:1

² 5,345,012 was filed 3 November 1993.

³ On 21 October 1997, 08/510,992 issued as Patent No. 5,679,873.

Appeal No: 2000-0635

Application No: 08/511,028

and (2) that at least 10% of the water present in the acid phase is removed, while the instant application teaches of removing at least 5% of the water from the acid phase.

37 CFR § 1.192 states that, in the appeal brief, applicants' argument shall specify the error in the rejection and the specific limitations in the rejected claims which cause the rejection to be in error.

Applicants argue that claims 1-10 are patentably distinct from the claims of Schieb because the claims require that some mononitrotoluene (MNT) remain in the reaction mixture. According to applicants, a nitric acid to toluene ratio of 2:1, as claimed by Schieb, would achieve complete conversion of toluene to dinitrotoluene leaving no MNT in the reaction mixture (Paper 13 (Rep. Br.) at 2).

In their appeal brief, applicants do not present any specific argument regarding the limitation in their claims requiring removal of at least 5% of the water from the acid phase and therefore we assume that applicants do not rely on the limitation as a ground for arguing that the examiner's rejection of the claims is in error.

DISCUSSION

Obviousness-type double patenting:

Appeal No: 2000-0635
Application No: 08/511,028

Obviousness-type double patenting is a judicially created doctrine that prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. A terminal disclaimer may overcome an obviousness-type double patenting rejection, assuming that the earlier patent has not expired. In re *Lonardo*, 119 F.3d 960, 965, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997). No terminal disclaimer is of record in the application.

Generally, a one-way test is applied and the relevant inquiry is whether the application claims are obvious in view of the earlier patented claims. See In re *Berg*, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). We apply a one-way test since applicants, in their brief, have not suggested that a two-way analysis should be applied nor pointed to a reason why a two-way analysis would be appropriate.

Applicants argue that the claimed ratio of "at least 1.5:1 such that some mononitrotoluene will remain in the reaction mixture" is not rendered obvious by the Schieb claimed ratio of "at least 2:1".

Appeal No: 2000-0635
Application No: 08/511,028

We agree with the examiner that a ratio of "at least 1.5:1" encompasses a ratio of "at least 2:1" since a range of 2.0 to some unspecified upper limit falls within a range of 1.5 to some unspecified upper limit. In other words, a ratio of at least 2:1 is a species of the ratio of at least 1.5:1. A later genus is not patentable over an earlier species. Eli Lilly v. Barr Laboratories, ___, 55 USPQ2d 1609, 1619 (Fed. Cir. 2000).

Applicants argue that the examiner's reasoning ignores that there is an upper limit for the ratio since the application claims require that some MNT remain in the reaction mixture. According to applicants, at the nitric acid to toluene molar ratio of 2:1 required by Schieb, no MNT would theoretically be present (Paper 13 at 2).

Applicants' disclosure tends to indicate otherwise. For example, page 5 of the disclosure states that "[w]hen the molar ratio of nitric acid to toluene is ≥ 2.0 , MNT is still present in the nitration reaction mixture". Example 1 discloses a nitrating acid to toluene molar ratio of 5.384:2.692 (or 2:1) resulting in a reaction mixture which is said to contain residual MNT (Paper 1 (Spec.) at 5). While it is true that applicants' own disclosure may not be used as

Appeal No: 2000-0635
Application No: 08/511,028

prior art, a description of the claimed invention contained within the disclosure can be used to compare the invention to the prior art. See In re Thorpe, 777 F.2d 695, 697-98, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicants have pointed us to no sufficient evidence of record that would indicate that their disclosure is in error and that a nitric acid to toluene ratio of at least 2.0 (or 2:1) would result in a reaction mixture devoid of MNT. The arguments of counsel cannot take the place of evidence lacking in the record. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997).

Applicants have not convinced us that the claimed ratio of "at least 1.5:1 such that some mononitrotoluene will remain in the reaction mixture" is patentably distinct from the Scheib claimed ratio of "at least 2:1". Accordingly, we affirm the rejection of applicants' claims under the doctrine of obviousness-type double patenting.

35 USC § 103:

Applicants' arguments addressing the examiner's rejection of the claims under 35 USC § 103 in view of Schieb are basically the same as the arguments addressing the rejection of the claims under the doctrine of obviousness-type double

Appeal No: 2000-0635
Application No: 08/511,028

patenting. Since we do not agree with applicants' arguments that Schieb does not teach a ratio of nitric acid to toluene such that MNT would remain in the reaction mixture, we affirm the rejection of applicants' claims under 35 USC § 103.

No time for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

_____)	
FRED E. McKELVEY, Senior)	
Administrative Patent Judge)	
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_____)	
RICHARD E. SCHAFER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
_____)	
SALLY GARDNER-LANE)	
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Appeal No: 2000-0635
Application No: 08/511,028

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